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09/827,489	04/06/2001	Jarmo Makela	297-006914-US (C01)	5743
2512 PERMAN & GREEN 425 POST ROAD FAIRFIELD, CT 06824	7590 12/10/2008		<div>EXAMINER</div> <div>ELAHEE, MD S</div>	
			<div>ART UNIT</div> <div>2614</div>	<div>PAPER NUMBER</div>
			<div>MAIL DATE</div> <div>12/10/2008</div>	<div>DELIVERY MODE</div> <div>PAPER</div>

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

09/827,489

**Applicant(s)**

MAKELA ET AL.

**Examiner**

MD S. ELAHEE

**Art Unit**

2614

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 April 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-144a or PTO-804a)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

### **DETAILED ACTION**

Examiner has decided to open up the prosecution based on some 35 U.S.C. 112 rejections of the pending claims not previously given.

#### ***Response to Amendment***

1. This action is responsive to an amendment filed on 06/06/2008. Claims 1-42 are pending. Claims 41 and 42 have been newly added.

#### ***Response to Arguments***

2. Applicant's arguments filed on 06/06/2008 Remarks have been fully considered but they are not persuasive.

Regarding claim 23, the applicant argues on pages 2-5 that no combination of Kang and Mizikovsky to teach the features of the presently claimed subject matter. It is because, Mizikovsky does not disclose such a portable entity and the vehicle radiotelephone of Kang clearly is not portable. Examiner respectfully disagrees with this argument. The reason of this disagreement has already been written in the previous office action mailed 03/06/2008.

Thus the examiner maintains the rejection of the claims in view of Mizikovsky and Kang.

#### ***Drawings***

3. The drawing of fig.3 is objected to under 37 CFR 1.83(a) because they fail to show a legend describing the labels on the Figure as described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended

replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled “Replacement Sheet” in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-23, 41 and 42 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter i.e., which of said plurality of forms of communication is employed in the selected response of claim 1 (lines 9-10), which of said plurality of forms of communication is employed in the selected response of claim 20 (lines 7-8) and which of said plurality of modes of response is employed in a selected response of claim 23 (lines 10-11), which was not described in the specification in

such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. One of ordinary skill in the art would not be able to associate a selected response to multiple forms/modes of communication/response.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Regarding claim 1, the phrases 'said step of sending a reply' on line 8 and 'the action' on line 9 lacks sufficient antecedent basis because it appears that the phrase 'said step of sending a reply' should be 'a step of sending said reply' and the phrase 'the action' should be 'an action'. Claims 20, 23-25, 29, 33 and 37 are rejected for the same reasons as discussed above with respect to claim 1. Since claims 2-19, 21, 22, 26-28, 30-32, 34-36 and 38-42 are dependent claims, these claims are also rejected.

8. Claims 1-42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Regarding claim 1, the phrase 'exclusively through the action of said portable terminal' on line 9 is confusing. It is because, it is not clear whether the phrase indicates '**only** through the action of said portable terminal' or '**excluding** through the action of said portable terminal'. Claims 20, 25, 29, 33 and 37 are rejected for the same reasons as discussed above with

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respect to claim 1. Since claims 2-19, 21, 22, 26-28, 30-32, 34-36 and 38-42 are dependent claims, these claims are also rejected.

9. Claims 20-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 20, the phrase "said reply" in line 5 is indefinite. There are two different "a reply". It is unclear which "reply" is being referred to by the phrase.

Claim 23 is rejected for the same reasons as discussed above with respect to claim 20. Since claims 21, 22 and 42 are dependent upon claim 20, these claims are also rejected.

#### ***Allowable Subject Matter***

10. Claims 10-11, 18-19, 21-22, 27, 31, 35 and 39 will be allowed after overcoming rejection under 35 U.S.C. 112.

11. Claims 41 and 42 are objected to as being dependent upon a rejected base claim, but would be allowable after overcoming rejection under 35 U.S.C. 112 if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Double Patenting***

12. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground

provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

13. Claims 1-42 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-32 of U. S. 6,301,338. Because claims in the pending application are broader than the ones in patent, In re Van Ornum and Stang, 214 USPQT61, broad claims in the pending application are rejected as obvious double patenting over previously patented narrow claims. For example, claim 1 of the pending application is the same as claim 1 of the patent except that claim 1 of the pending application does not recite the types of reply messages. Therefore, claim 1 of the pending application is broader than claim 1 of the patent.

#### ***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

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2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

16. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

17. Claims 1,7-9, 12-13, 20, 23-26, 29, 30, 33, 34, 37 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Mizikovsky** in view of **Kang** (US 5,058,150).

As to Claims 1,20,23-25,29,33 and 37, with respect to Figures 1-2 and 5, **Mizikovsky** teaches a method for replying to a call coming to a portable terminal (mobile station 10, Fig.1) wherein, in response to the incoming call,

the portable terminal identifies the caller on the basis of caller ID [i.e., an identification information] (Col. 11, lines 8-15), or

**Mizikovsky** further teaches directing the incoming call to a selected accessory device such as a telephone answering machine (Col. 12, line 30) to service or answer the call (Col. 12, line 34).



**Mizikovsky** further teaches selecting an accessory device (i.e., telephone answering machine (hereinafter TAD)) and the device answers or service the call uniquely (such as TAD generates outgoing message (i.e., OGM) or fax machine generates CNG tone (i.e., calling tone) when making a call and sends CED tone when responding an incoming fax call) (Col. 6, lines 51-67, Col. 7, lines 27-30). Thus, the selected device answers the call reads on claimed “reply”. Also, each selected device must treat/service the call uniquely therefore, each device can produce a specific form of communication to the incoming call such as TAD generates OGM or fax machine generates CNG tone when making a call and sends CED tone when responding an incoming fax call (Col. 12, lines 25-37).

**Mizikovsky** further teaches the step of identifying the caller is accomplished by the portable terminal (Figure 1, label 50, Figure 2, label 114 and Figure 5, label 516).

**Mizikovsky** does not explicitly teach that the portable device sends the reply and provides a selected response to the caller **exclusively through the action of the portable terminal** irrespectively of which of said plurality of forms of communication is employed in the selected response.

In other words, **Mizikovsky** does not explicitly teach that a selected accessory device (i.e., TAD) responses are exclusively sent through the mobile terminal. Also, **Mizikovsky** does not explicitly teach that the selected device (i.e., TAD) is integrated into the mobile device.

**Kang** teaches that voice analyzing/synthesizing circuit (Fig.2,3, item 221) which is actually telephone answering machine, has been included and integrated into a radio telephone (Fig.2). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to integrate the TAD of **Mizikovsky** into the mobile station of **Mizikovsky** so that

user are not required to any external connection to connect to the external TAD to get the benefit of carrying both of the TAD along with the mobile station easily as one unit.

As to Claim 7, **Mizikovsky** teaches a method in accordance with claim 1, wherein said reply is at least partly formulated based on the identification of the calling party (Figure 5, label 506).

As to Claim 8, **Mizikovsky** teaches a method in accordance with claim 7 wherein a reply is sent to certain identified calling parties only (Figure 5, labels 508,512).

As to Claim 9, **Mizikovsky** teaches a method in accordance with claim 7, wherein the reply to be sent in response to the incoming call is different according to the respective company said call is coming from (Figure 5, labels 508,512,516).

As to Claims 12-13, **Mizikovsky** teaches a method in accordance with claim 7, wherein said identification of the calling party is based on registered caller IDs (a telephone notebook) comprised by the communication (Figure 2, label 106).

As to Claims 26,30,34,38, **Mizikovsky** teaches a portable terminal in accordance with claim 25, wherein said step of taking response action comprises sending a reply to the caller, said reply being a voice message (one of the following: a voice message, e-mail message, facsimile, and an SMS message in the form of a character string) (Col. 8, lines 51-59).

18. Claims 2, 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Mizikovsky** in view of **Kang** further in view of **Jambhekar** et al. (US 5,848,356).

As to Claims 2,6, **Mizikovsky** teaches a method in accordance with Claim 1, wherein the portable terminal sends said reply immediately in response to an incoming call, and said plurality of forms of communication include a voice message.

**Mizikovsky** further teaches a facsimile peripheral which suggests a facsimile accessory and facsimile message; a multimedia terminal which suggests an e-mail accessory and response; EIA/TIA 15-54 alert messages which suggests a SMS accessory and response.

However, **Mizikovsky** in view of **Kang** does not teach, “an e-mail message, a facsimile message, and an SMS message in the form of a character string”. **Jambhekar** teaches e-mail, facsimile and SMS messages (Figures 5P and 8A). Having the cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add e-mail, facsimile and SMS capabilities to **Mizikovsky**’s invention in view of **Kang**’s invention for providing callers with response messages as taught by **Jambhekar**’s invention in order not to distract a user by sending pre-programmed responses.

19. Claims 3-5,28,32,36,40 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Mizikovsky** in view of **Kang** further in view of **Bremer** (US 6,018,671).

As to Claim 3, **Mizikovsky** teaches a method in accordance with Claim 1, wherein in response to an incoming call,

**Mizikovsky** teaches providing users with alert signals and, therefore, waits for a user response (Figure 5, label 510). However, **Mizikovsky** in view of **Kang** does not teach, “the portable terminal alarms and waits during a certain delay, and if a user during said delay does not answer said call, the portable terminal sends said reply”. **Bremer** teaches the limitation (Figure 4, labels 4 16,420). Having the cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add default capability to **Mizikovsky**’s invention in view of **Kang**’s invention for providing callers with default messages as taught by Bremer’s invention in order not to keep a caller waiting.

As to Claims 4,28,32,36,40, **Mizikovsky** teaches a method in accordance with claim 1, wherein in response to an incoming call, the portable terminal alarms, and:

**Mizikovsky** teaches providing users with alert signals and, therefore, waits for a user response (Figure 5, label 510). However, **Mizikovsky** in view of **Kang** does not teach, “if a user gives a certain key command, the portable terminal sends said reply”. Having the cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add selected message capability to **Mizikovsky**’s invention in view of **Kang**’s invention for providing callers with selected messages as taught by Bremer’s invention in order not to keep a caller waiting.

As to Claim 5, **Mizikovsky** teaches a method in accordance with claim 3, wherein the portable terminal gives a mute soundless alarm (Col. 6, lines 43-50).

20. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Mizikovsky** in view of **Kang** further in view of **Villa-Real** (US 4,481,382).

As to Claim 14, **Mizikovsky** teaches a method in accordance with claim 7.

**Mizikovsky** teaches providing selected accessory responses to callers (Figure 5, label 518). However, **Mizikovsky** in view of **Kang** does not teach, “wherein a reminder to call the identified calling party will be stored into the portable terminal, in order to be presented to a user later”. Having the cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add reminder capability to **Mizikovsky**’s invention in view of **Kang**’s invention for alerting users as taught by **Villa-Real**’s invention in order to provide reminders to users when calls become due.

21. Claims 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Mizikovsky** in view of **Kang** further in view of **Wolff** et al. (US 5,327,486).

As to Claims 15-17, **Mizikovsky** teaches a method in accordance claim 1, wherein said reply includes:

**Mizikovsky** teaches providing callers with selected user accessory responses (Figure 5, label 518). However, **Mizikovsky** in view of **Kang** does not teach, “time information”. **Wolff** teaches the limitation (Figures 8-9). Having the cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add time capability to

**Mizikovsky's** invention in view of **Kang's** invention for providing callers with selected time-based messages as taught by **Wolff's** invention in order not to keep a caller waiting.

### *Conclusion*

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MD S. ELAHEE whose telephone number is (571)272-7536. The examiner can normally be reached on Mon to Fri from 9:00am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/MD S ELAHEE/  
MD SHAFIUL ALAM ELAHEE  
Primary Examiner  
Art Unit 2614  
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